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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,981	10/20/2004	Orlaw Massler	H37-116 US	7187
21706	7590	04/25/2006	EXAMINER	
NOTARO AND MICHALOS 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100			TURNER, ARCHENE A	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/511,981

Applicant(s)

MASSLER ET AL.

Examiner

Archene Turner

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2,3,17,18, 20,21,29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 appears to now be the same as claim 2. Claim 18 appears to be the same as claim 17 and similarly, claim 21 appears to be the same as claim 20. In claim 29 there are 2 disclosure of DLC, rendering the claim indefinite.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,3,4,9-26,28,30,33-44,46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goetze (DE 3634708)

Goetze discloses a slide coating within the claimed thickness having the claimed holes therein. Goetze does not describe the coating made by the claimed CVD or PVD process, but it would have been obvious to one of ordinary skill in the art that the disclose coating could be produced by the claimed methods, as these methods are well known in the art to produce coatings. It would have also been

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obvious to one of ordinary skill in the art to use this discontinuous coating on other work pieces as claimed, as these tools are known in the art to use the same coatings.

Applicant's arguments filed 2-03-06 have been fully considered but they are not persuasive. The applicant argues that amending the claims to include the CVD or PVD method overcomes Goetze. The examiner does not find this persuasive since the technique to produce the coating does not provide a novel feature to the product, and thus the reference is maintained. The applicant also argues whether the chromium coating should be considered a slide layer. The applicant is reminded that the independent claim does not limit the coating.

5. Claims 2,5,6,8, 27,29,31,32,45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goetze (DE 3634708) and Massler et al (6,740,393)

Goetze discloses the claimed microstructure but not the claimed layer.

Massler et al discloses the claimed slide layer.

Thus it would have been obvious to one of ordinary skill in the art to substitute the layer of Goetze the layer of Massler et al, as the layer of Massler et al is known to be functionally equivalent if not better than the earlier metal layers disclosed by Goetze.

6. Claims 2,5-7,27,29,31,32,45 rejected under 35 U.S.C. 103(a) as being unpatentable over Goetze (DE 3634708) and Sumitomo (JP 200-178720).

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Goetze discloses the claimed microstructure but not the claimed layer.

Sumitomo discloses the claimed layer.

Thus it would have been obvious to one of ordinary skill in the art to substitute the layer of Goetze or with the layer of Sumitomo, as the layer of Sumitomo is known to be functionally equivalent if not better the earlier metal layers disclosed by Goetze.

7. Applicant's arguments filed 2/6/06 have been fully considered but they are not persuasive. The applicant argues that one of ordinary skill would not look to Massler or Sumitomo to combine with Goetze. The examiner disagrees. Massler and Sumitomo disclose coatings that improve the performance of substrates and one of ordinary skill would know to substitute these coatings in Goetze to improve performance, and thus the arguments are not persuasive and the rejections stand.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Archene Turner whose new telephone number is (571) 272-1545. The examiner can normally be reached on Monday, Wednesday through Friday from 10:30 am. to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Please remember to include on the fax, the art unit 1775, serial number and Examiner's name.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ARCHENE TURNER
PRIMARY EXAMINER